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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)									
		016295.0697									
I certify that this communication is submitted to the U.S. Patent and Trademark Office (USPTO) through the Electronic Filing System (EFS) on the below date: on <u>April 21, 2009</u> Signature <u><i>Crystle Garbade</i></u> Typed or printed name <u>Crystle Garbade</u>		Application Number <u>09/961,218</u>	Filed <u>September 21, 2001</u>								
		First Named Inventor <u>Michael E. Brown</u>									
		Art Unit <u>2145</u>	Examiner <u>Bhatia, Ajay M.</u>								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u><i>Brian K. Prewitt</i></u> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Brian K. Prewitt</u> Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. <u>60,135</u> Registration number</td><td><u>512.322.2684</u> Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</td><td><u>April 21, 2009</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	<u><i>Brian K. Prewitt</i></u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Brian K. Prewitt</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. <u>60,135</u> Registration number	<u>512.322.2684</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34	<u>April 21, 2009</u> Date
<input type="checkbox"/> applicant/inventor.	<u><i>Brian K. Prewitt</i></u> Signature										
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael E. Brown *et al.*
Serial No.: 09/961,218
Date Filed: September 21, 2001
Group Art Unit: 2145
Confirmation No.: 4097
Examiner: Bhatia, Ajay M.
Title: **SYSTEM AND METHOD FOR NAMING
HOSTS IN A DISTRIBUTED DATA
PROCESSING SYSTEM**

MAIL STOP – APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST AND ARGUMENTS

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). At the time of the Office Action mailed January 21, 2009, Claims 1-12 and 14-22 were pending in this Application. Claims 1-12 and 14-22 were rejected. No claim amendments are hereby requested. Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1-12 and 14-22 on prior art grounds contain clear legal and factual deficiencies, as described below. Claims 1-12 and 14-22 are pending. Claims 1-4, 6, 9-11, 16-18, and 22 stand rejected under 35 U.S.C. § 103(a) as being as being unpatentable over U.S. Patent Publication No. 2002/0161868 filed by Paul *et al.* (*Paul*) in view of U.S. Patent No.: 5,974,547 to Yevgeniy Klimenko (*Kilmenko*). Dependent Claims 5, 7, 8, 12, 14, 15, 19, 20, and 21 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Paul*, *Kilmenko*, in further view of U.S. Patent No. 5,864,656 to Jee-Kyoung Park (*Park*).

Applicants contend that the rejections of Claims 1-12 and 14-22 are not proper for at least the reasons described in Applicants' Request for Continued Examination filed December 10, 2008 at Pages 10-21 ("Applicants' Response"). In short, Applicants contend that, contrary to the Examiner's assertions, the cited references do not teach or suggest, either alone or in combination, each and every element of the recited claims.¹

Rejections under 35 U.S.C. §103

As set forth in Applicants' Response, Applicants respectfully submit that *Paul*, *Kilmenko*, and *Park* each fail to teach or suggest all the elements of at least the independent Claims. For example, Independent Claim 1 recites, in part:

receiving a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, while at least one of the plurality of hosts is executing in a pre boot execution environment;
in response to receiving the UIDs, causing the plurality of hosts to produce ready signals;
receiving user input from a first host among the plurality of hosts, the user input comprising notification of the insertion of a disk within the first host;
in response to receiving the user input from a first host, associating a first host name with the UID for the first host;
after associating the first host name with the UID for the first host, causing the first host to produce a completion signal;
receiving user input from a second host among the plurality of hosts; and
repeating the operations of receiving replies from hosts, associating host names with UIDs, and causing hosts to produce completion signals, until each of the plurality of hosts has been named, such that the user input dictates the order in which host names are assigned to the multiple hosts.

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

Independent Claims 9 and 16 recite similar elements. Applicants submit that at least these elements are missing in the cited references.

Independent Claims 1, 9, and 16

Independent Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Paul* in view of *Klimenko*. Applicants disagree.

The Examiner has suggested that in Paragraph [0032], *Paul* discloses “providing a UID.” (Office Action, Page 2). However, Paragraph [0032] only provides how a PXE specifies the communication protocols that a client may use to request an NBP. *See* Applicants’ Response, Pages 12-13. This paragraph is silent to any teachings or suggestions, and the Examiner has failed to point where specifically in the relied upon paragraphs of *Paul* that includes *receiving a unique identifier (UID) at a cluster controller from each of a plurality of hosts* in communication with the cluster controller, as recited in Independent Claim 1.

As another example, the Examiner argues that the ready signal recited in Claim 1 is “interpretable as the request to download the specified NBP” recited in Paragraphs [0035] and [0038]. (Office Action, Pages 2 and 5). Applicants disagree. However, for argument sake, even if the Examiner’s interpretation is correct, the request to download the specified NBP is not *in response to receiving the UIDs*, as recited in Independent Claim 1. Further, Paragraphs [0035] and [0038] does not *cause a plurality of host to produce ready signals*, as recited in Claim 1. *See* Applicants’ Response, Pages 13 - 14.

The Examiner contends that while *Paul* fails to teach or suggest receiving user input from a first host among the plurality of hosts, the user input comprising notification of the insertion of a disk with the first host, *Klimenko* discloses this element. The Examiner refers to Column 4, Lines 17-63 suggesting that Interrupt 13 uses a “BIOS to notify the system of the insertion of the disk.” (Office Action, Page 3). Applicants submit that the Examiner has failed to provide evidence within relied upon sections of *Klimenko* to support this contention. Rather, on the contrary, in the relied upon passage, *Klimenko* merely discloses that Interrupt 13 “handles hard disk emulation.” *See* Applicants’ Response, Pages 14-15. Thus, *Klimenko* fails to teach or suggest *receiving user input from a first host among the plurality of hosts, the user input comprising notification of the insertion of a disk with the first host*, as recited in Claim 1.

In another example, the Examiner contents that *Paul* discloses that in response to receiving the user input from a first host, *associating a first host name with the UID for the first*

host and cites to Paragraphs [0035] and [0043]. *See* Office Action, Pages 3 and 5. As noted in Applicants' Response, the relied upon section fails to disclose, teach, or suggest a host name and a UID much less *associating a first host name with the UID*, as recited in Claim 1. *See* Applicants' Response, Page 16. The Examiner has failed to show which element within the cited passages correlate to a UID and which element correlates to a host name and where the association is made.

The Examiner, after Applicants specifically requested in Applicants' Response that the Examiner comply with 37 C.F.R. § 1.104 and 35 U.S.C. § 132, cited that Paragraphs [0032], [0035], and [0037] and in particular, that the PXEClient tag teaches or suggests a completion signal. *See* Office Action, Pages 3 and 5. However, the Examiner does not convey where in *Paul* the PXEClient tag is produced by a first host *after associating the first host name with the UID for the first host*, as recited in Claim 1. Applicants submit that this element is absent in *Paul*.

The Examiner relies upon Paragraphs [0052] and [0043] of *Paul* and claims that these sections teach or suggest repeating the operations of receiving replies from hosts, associating host names with UIDs, and causing hosts to produce completion signals, until each of the plurality of hosts has been named, *such that the user input dictates the order in which host names are assigned to the multiple hosts*, as recited in Claim 1. Further, the Examiner relies on *Klimenko* and contends that *Klimenko* "discusses the user input of the disk." (Office Action, Page 3). Again, the Examiner has failed to comply with 37 C.F.R. § 1.104 and 35 U.S.C. § 132 as the Examiner has provided no evidence within *Klimenko* that supports the Examiner's contention. With respect to *Paul*, as noted in Applicants' Response, the relied upon section of *Paul* refers to a packet request by a PXE client and the response from the boot server(s) to this request. *See* Applicants' Response, Pages 17-18. Applicants submit that nowhere in the relied upon sections does *Paul* teach or suggest (1) receiving replies from hosts; (2) associating host names with UIDs; (3) causing hosts to produce completion signals, until each plurality of hosts have been name; and (4) *such that the user input dictates the order in which hosts names are assigned to the multiple hosts*.

With respect to the *Park* reference, *Park* fails to teach or suggest the above-recited elements. Particularly, *Park*, separately or combined with *Paul* and/or *Klimenko*, fails to teach or suggest all the elements of Independent Claim 1. For analogous reasons, *Paul*, *Klimenko*,

and/or *Park* also fail to teach or suggest similar elements recited in Independent Claims 9 and 16. Accordingly, the cited references cannot render Claims 1, 9, and 16 obvious.

For at least these reasons, *Paul*, *Klimenko*, and *Park*, either separately or as combined by the Examiner, fails to disclose each and every limitation of independent Claims 1, 9, and 16. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under § 103(a) over full allowance of Claims 1, 9, and 16 and their respective dependent claims.

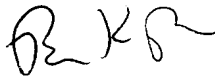
CONCLUSION

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicant authorizes the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$540.00 for the Notice of Appeal.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2684.

Respectfully submitted,
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Attorney for Applicants



Brian K. Prewitt
Reg. No. 60,135

Date: April 21, 2009

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